

REMARKS

This is in response to the Office Action of January 5, 2007. Claims 17, 18, and 46 are cancelled – without prejudice – in order to expedite the prosecution of this application. Claim 26 is amended to agree with claim 1 from which it depends. Claims 1 and 5 are amended to recite viscosity, based upon disclosure in the paragraph in lines 1-8 on page 6 of the specification. Claim 14 is accordingly cancelled, and the dependency of claim 45 is amended. No new matter is introduced into the application by this Amendment. With this Amendment, claims 1, 3, 5-8, 11, 12, 15, 16, 20-24, 26, 31, 32, 41-45, 47, and 48 remain pending in the application.

Claims 17, 18, 26, and 46 were rejected under the second paragraph of 35 U.S.C. §112 as failing to define the invention properly. Claims 17, 18, and 46 are cancelled, and claim 26 is amended to find proper antecedent basis in claim 1 from which it depends. It is respectfully submitted that this ground of rejection has therefore been obviated.

Claims 1, 3, 5, 7, 8, 11, 12, 15-18, 20-24, 26, 31, 32, 42-44, and 46-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over GB 2 093 679 A (“Oven”) in view of US 5,529,800 (Bourns). Inasmuch as independent claims 1 and 5 now recite the feature of former claim 14, which was not rejected on this ground, this ground of rejection needs no further consideration.

Claims 6 and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oven in view of Bourns and US 5,871,781 (Myers). Inasmuch as claims 5 and 1, from which claims 6

and 41 depend, now recite the feature of former claim 14, which was not rejected on this ground, this ground of rejection needs no further consideration.

Claims 14 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oven in view of Bourns and US 5,011,704 (Smagula). The rejection is respectfully traversed.

The present invention provides *liquid* food compositions which resist separation on standing and which provide greatly improved adhesion characteristics. Specification, page 6, lines 1-8. Fudge sauce, allegedly disclosed by Smagula, is not a type of sauce contemplated by claims 1, 3, 5-8, 11, 12, 15, 16, 20-24, 26, 31, 32, 41-45, 47, and 48 herein, which in which the composition "is not a sugar-in-oil suspension" and "has a viscosity in the range from 30 mPas⁻¹ to 200 mPas⁻¹".

The Examiner indicates, on page 5 of the Office Action, that the Oven reference — by disclosing milling taking place in one step — inherently discloses monomodal particle size distribution. There is absolutely no evidence of record to indicate that the milling carried out in GB 2,093,679 would provide the particle size and monomodal distribution required by the present invention. As disclosed in Applicants' specification, monomodal particle size distribution as required by the present claims can be achieved either by milling the components separately *to a desired consistent particle size* or by blending the components and milling the blend or mixture together *to the desired size*. No such processing to attain a desired monomodal particle size distribution is disclosed in GB 2,093,679. If the Examiner persists in taking the position that the Oven reference provides a product with monomodal particle size distribution, he is respectfully requested to document that assertion.

This rejection over Oven in view of Bourns and Smagula is founded on the Examiner's assertion that

It would have been obvious to one of ordinary skill in the art that the combined product of GB 2093679A, in view of Bourns et al, would have provided an adhesiveness of at least 85% since the same materials were used, since GB 2093679A simply did not recite an adhesion value, since the "collet adhesion test" of applicants (page 11, lines 10) was not a regulated or uniformly applied standard in the art, and since a greater degree of adhesion would have been beneficial by more efficiently applying the composition of GB 2093679A to a food.

It is respectfully submitted that this assertion, or rather -- this group of assertions -- lacks sustainable logic. We will consider each assertion in turn.

"It would have been obvious to one of ordinary skill in the art that *the combined product of GB 2093679A, in view of Bourns et al*, would have provided an adhesiveness of at least 85% since the same materials were used". Evidence of unexpected results must compare the claimed invention with the closest prior art. However, an applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. §103(a) "would be requiring comparison of the results of the invention with the results of the invention." 357 F.2d at 422, 148 USPQ at 714.). Basically, what the PTO is saying here is that if the Oven compositions were modified (in view of Bourns) to become Applicants' compositions, they would have the same properties as Applicants' compositions. While this logic is irreproachably correct, it has no bearing on an obviousness rejection under 35 U.S.C. §103(a), which requires a comparison of an applicant's invention not with itself but with

something actually disclosed in a prior art reference. This logic by the PTO fails to demonstrate in the prior art the feature “composition [having] a viscosity in the range from 30 mPas⁻¹ to 200 mPas⁻¹ and [having] an adhesiveness, measured by the collet adhesion test, of greater than 85%”, which feature is required by all of the claims in the present application.

“It would have been obvious to one of ordinary skill in the art that the combined product of GB 2093679A, in view of Bourns et al, would have provided an adhesiveness of at least 85% ... since GB 2093679A simply did not recite an adhesion value”. What the PTO appears to be saying here is that since Oven fails to disclose any adhesion values, his compositions must have an adhesiveness of at least 85%. This is clearly faulty reasoning.

“It would have been obvious to one of ordinary skill in the art that the combined product of GB 2093679A, in view of Bourns et al, would have provided an adhesiveness of at least 85% ... since the “collet adhesion test” of applicants (page 11, lines10) was not a regulated or uniformly applied standard in the art”. What the PTO appears to be saying here is that since the collet adhesion test is allegedly not standard, his compositions must have an adhesiveness of at least 85%. This is clearly faulty reasoning.

“It would have been obvious to one of ordinary skill in the art that the combined product of GB 2093679A, in view of Bourns et al, would have provided an adhesiveness of at least 85% ... since a greater degree of adhesion would have been beneficial by more efficiently applying the composition of GB 2093679A to a food”. What the PTO appears to be saying here is that since the Oven compositions could be improved by making them more like Applicants’ compositions, it would be obvious to do so. This is clearly faulty reasoning.

Applicants respectfully submit that the Examiner has not stated a sustainable *prima facie* obviousness rejection based upon the Oven, Bourns, and Smagula references with respect to any of claims 1, 3, 5-8, 11, 12, 15, 16, 20-24, 26, 31, 32, 41-45, 47, and 48 currently pending in the application.

Withdrawal of all rejections of record is in order and is earnestly solicited. If the Examiner has any questions concerning this application, he is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

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Respectfully submitted,

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